

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated June 28, 2006 (hereinafter Office Action) have been considered. Each of the asserted references appears to be unrelated to the instant invention; therefore, reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

With respect to both of the §103(a) rejections, each of which relies upon at least the asserted combination of U.S. Patent No. 6,021,315 to Telewski (hereinafter "Telewski") in view of U.S. Patent No. 5,968,191 to Thatcher *et al.* (hereinafter "Thatcher"), Applicant respectfully traverses the rejections because the cited references, alone or in combination, do not teach each of the claimed limitations. The Examiner acknowledges that Telewski does not teach the limitations of the independent claims set forth in the body of each of the independent claims. The Examiner's attempt to overcome these deficiencies by relying on the teachings of Thatcher is misplaced as Thatcher also fails to teach each of the claimed limitations. For example, Thatcher at least fails to teach measuring effective values of node voltages, as claimed. Thatcher teaches measuring interconnections between two IC's and only teaches measuring node voltage at a point, not measuring in at least two nodes of a current path where a node represents an equipotential point of adjacent electric components, as claimed. Applicant further fails to recognize where Thatcher teaches a predefined network configuration, as claimed. Thus, Thatcher cannot teach deriving a characterizing value of at least one electric component using the effective value of the current, the effective values of the node voltages, and the predefined network configuration. As neither of the cited references teaches the above-discussed limitations, any combination of these references must also fail to teach the limitations. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejections are improper and should not be maintained. Applicant accordingly requests that the rejections be withdrawn.

Dependent Claims 2-10, 12, 13, 15-23 and 25 depend from independent Claims 1 and 14, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Telewski and

Thatcher. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1 and 14. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-10, 12, 13, 15-23 and 25 are also allowable over the combination of Telewski and Thatcher.

With particular respect to the rejection of dependent Claims 3 and 16, Applicant respectfully traverses because the asserted combination of references does not teach each of the claimed limitations. Applicant notes that the cited portion of Thatcher teaches converting analog voltage and feeding it to a computer 120 for determining the value of the components. There is no discussion that the value of the components (asserted to be a characterizing value) is derived by using a closed-form mathematical expression formed according to the predefined network configuration as no closed-form mathematical discussion is taught by Thatcher. While the Examiner appears to assert that using such an expression would be inherent, the Examiner has not provided any of the requisite evidence for asserting inherency. Applicant notes that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). MPEP §2112 further states that "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49

USPQ2d 1949, 1950-51 (Fed. Cir. 1999).” The Examiner has not provided any evidence that Thatcher, or Telewski, would use a closed-form mathematical expression formed according to the predefined network configuration to determine component values. Thus, the asserted combination does not teach the claimed limitations, and the limitations have not been shown to be inherent. Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the rejection of dependent Claims 4 and 17, Applicant respectfully traverses because the asserted combination of references does not teach each of the claimed limitations. The cited portion of Thatcher specifically teaches that constant current is fed through closed switches. *See, e.g.*, column 2, lines 5-9 and column 3, line 40. Thus, Thatcher does not teach deriving a characterizing value using the frequency associated with the current, as claimed. Without a presentation of correspondence to each of the claimed limitations, the rejection is improper, and Applicant accordingly requests that it be withdrawn.

With particular respect to the rejection of dependent Claims 5, 6, 18 and 19, Applicant respectfully traverses because the asserted combination of references does not teach each of the claimed limitations. Applicant fails to recognize where the cited portions of Thatcher teach using any known values, as claimed, to derive a characterizing value. Without a presentation of correspondence to each of the claimed limitations, the rejection is improper, and Applicant accordingly requests that it be withdrawn.

In addition to having to show that the asserted combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to combine these references as asserted. Applicant respectfully submits that this requirement has not been met.

The Examiner proposes modifying Telewski to include Thatcher’s teaching of testing interconnections between IC’s “in order to test each component of the electric circuit as desired to ensure the quality or design.” However, the cited portion of Telewski specifically teaches that “While testing can be performed on portions of the circuit during the manufacturing process, it is desirable to test the completed product to assure proper

system operation.” Column 1, lines 26-29. Telewski is directed to post-manufacture testing of the operation of wireless devices. Telewski acknowledges that internal testing may be done, but is not directed to such testing. Moreover, Thatcher is entirely unrelated to testing electric components in a wireless device of a telecommunications system. Thus, a skilled artisan would not have used the teachings of Thatcher to modify Telewski to perform testing to which Telewski is not directed, and no evidence has been presented in support of such an assertion. Without a presentation of evidence from the cited references of motivation to modify the references as asserted, the §103(a) rejection is improper. Applicant accordingly requests that it be withdrawn.

Applicant respectfully asserts that the teachings of Telewski and Thatcher would provide insufficient guidance for a skilled artisan having these references before him/her to make the combination suggested by the Examiner. Applicant respectfully asserts that the Examiner’s conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant’s disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

As Telewski is not directed to internal testing of electric components and Thatcher is not directed to any testing of wireless communication devices, Applicant respectfully submits that the asserted combination simply does not contemplate the proposed combination. This piecemeal selection of elements is tantamount to mixing teachings out of context. Such a rejection is not permissible under §103. See *In re Kotzab*, 217 F.3d

1365 (Fed. Cir. 2000) (proposed modification must not be made in the abstract but rather made in view of the entire teaching of the prior art).

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the rejection of dependent Claims 11 and 24 based upon the combination of Telewski and Thatcher *et al.* and further in view of U.S. Patent No. 4,611,101 to Walter *et al.* (hereinafter “Walter”), Applicant respectfully traverses. As discussed above, the combination of Telewski and Thatcher fails to correspond to the limitations of independent Claims 1 and 14 (from which Claims 11 and 24 depend). The Examiner’s further reliance on Walter does not overcome the above-discussed deficiencies. Thus, the asserted combination of Telewski, Thatcher, and Walter does not teach each of the claimed limitations of dependent Claims 11 and 24, and the rejection should be withdrawn.

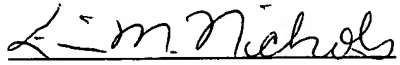
Applicant has amended the independent claims to characterize that the electric components being tested are part of an electric circuit of a wireless device of a telecommunications system. These changes do not introduce new matter as the limitations were present in the preamble of each of the amended claims. New Claim 27 has also been added. Support for Claim 27 may be found in Fig. 2, original Claim 14, page 6, lines 18-22, and page 9, lines 33-36 of the instant Specification. Thus, these changes do not introduce new matter and Claim 27 is believed to be patentable for the reasons discussed above in connection with independent Claims 1, 14, and 26.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.060PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,

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Date: September 25, 2006

By: 

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